

REMARKS/ARGUMENTS

Prior to entry of this Amendment, the application included claims 1-20. Claim 1 has been amended. No claims have been canceled or added. Hence, after entry of this Amendment, claims 1-20 stand pending for examination.

The Applicants note that the non-patent literature references listed in the Supplemental Information Disclosure Statement filed July 15, 2005, were not considered by the Examiner because they were not submitted. As indicated by the Applicants in the Supplemental Information Disclosure Statement, the non-patent literature references were not submitted, in accordance with 37 C.F.R. § 1.98(d), because they were previously submitted by the Applicants or cited by the Office in parent Application No. 09/516,209. The Applicants respectfully request that the Examiner review the non-patent literature references and return an initialed SB/08 to the undersigned attorney. Copies of the Supplemental Information Disclosure Statement, the PTO stamped postcard and the cited references are enclosed for the Examiner's convenience.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

Claims 1-7, 9-15 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. ("Wilf"), in view of the cited portions of U.S. Patent No. 5,826,241 to Stein et al. ("Stein"), and the cited portions of U.S. Patent Publication No. 2002/0004783 to Paltenghe et al. ("Paltenghe"), and the cited portions of U.S. Patent No. 5,758,126 to Daniels et al. ("Daniels"), and the cited portions of U.S. Patent No. 6,102,287 to Matyas, Jr. ("Matyas"), and the Applicants' Admitted Prior Art ("AAPA").

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilf, Stein, Daniels, Matyas and AAPA in view of the cited portions of U.S. Patent No. 5,920,847 to Kolling et al. ("Kolling").

Rejections Under 35 U.S.C. § 112

The Applicants have amended claim 1 as suggested by the Office Action to thereby overcome the 35 U.S.C. § 112 rejection. No new matter has been added.

Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the claim rejections under 35 U.S.C. § 103(a), because the Office Action has not established a case of prima facie obviousness with respect to any pending claim. Specifically, the references do not teach or suggest all of the claim elements, there exists no expectation that the references could be combined as suggested by the Office Action to produce the Applicants' claimed invention, and the motivation cited by the Office Action would not motivate one to combine the references as suggested by the Office Action. Hence, all pending claims are believed to be allowable.

Taking claim 1 as an example, the Applicants direct attention to the element, "from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." Claims 10 and 17 include a similar element. The cited references do not teach or suggest this. The Office Action appears to cite Stein for this teaching, but Stein does not teach or suggest a funds transfer server interacting with a pop-up window to present a transaction amount and receive a customer's assent to the transaction amount. The Office Action appears to assert that Stein's teaching of presenting a transfer amount through an Internet interface is the same as "interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." The Office Action states that "the ordinary practitioner of the art would have seen it as obvious at the time of the Applicants' invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer." This is tantamount to an admission that Stein does not teach or suggest the element, and the Office Action fails to cite another reference for this teaching. Specifically, neither Daniels nor Matyas teach or suggest this element. Moreover, while the Applicants remain unable to understand the

Office Action's reasoning regarding the alleged AAPA, even the supposed AAPA fails to teach or suggest "interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." Hence, claims 1, 10 and 17 are believed to be allowable, at least for this reason.

Further, there is no reasonable expectation that the cited references could be combined successfully to produce the Applicants' claimed invention, and the Office Action provides no discussion along these lines. For example, the Office Action appears to suggest that Paltenghe (implicitly) provides a transaction amount via an invoice, and Stein presents the transfer amount through an "internet interface." But Stein's payment system appears to be redundant to Paltenghe's virtual wallet. Where the two are not redundant, they appear to be incompatible. Hence, one skilled in the art would not expect the two references to be successfully combined to produce the Applicants' claimed invention. Expanding the combination to include the other cited references introduces similar shortcomings. Hence, claims 1, 10 and 17 are believed to be allowable, at least for this additional reason.

Further still, the Office Action cites a single motivation, suggesting that this motivation is sufficient grounds for combining all six references. It is not. Stein, for example, directly contradicts the motivation "to overcome the reluctance of some users to transmit credit card information over the internet," since Stein teaches doing just that. Expanding the combination to include other references results in similar flaws based on this motivation. Hence, claims 1, 10 and 17 are believed to be allowable, at least for this additional reason.

The remaining claims depend from one of the independent claims discussed above and are believed to be allowable, at least for the reasons stated above. Moreover, claims 12 and 13 are believed to be allowable because the Office Action states that the limitations are "implicit," which is not a proper rejection. This appears to be an argument for application of the doctrine of inherency for the missing limitations since a valid rejection cannot be maintained based on a claim element being "implicit" in a reference. All limitations must be taught or suggested by the cited references, which does not appear to be the case here. Giving the benefit of the doubt that the Examiner intended to state that the limitations are inherent, the Applicants

point out that the doctrine of inherency is only applicable when a missing limitation is necessarily present in a cited reference. That is not the case for either claim 12 or claim 13. With respect to claim 12, all pop-up windows do not necessarily overlay an existing web browser window, and the cited references do not teach such. The existing window may not occupy the entire screen, in which case, the pop-up may overlay a portion of the screen not occupied by the existing window. Further, some pop-up windows may position themselves behind an existing window, becoming visible only after the user closes the existing window. Hence, the element of claim 12 is not necessarily present in the teachings of the cited references. Likewise, not all pop-ups are triggered by receiving transaction information as recited in claim 13. Pop-ups may be triggered by any of a number of events other than receiving transaction information. Hence, the limitation of claim 13 is not necessarily present in the cited references, and claims 12 and 13 are believed to be allowable for this additional reason.

Conclusion

In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: October 26, 2007

/Irvin E. Branch/
Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB/jln
61157743 v1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

PATENT
Attorney Docket No.: 020375-002710US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 7/15/05

TOWNSEND and TOWNSEND and CREW LLP

By: Janet L. Newmaker
Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John Joseph Mascavage III, et al.

Application No.: 09/991,379

Filed: November 15, 2001

For: ONLINE PURCHASING METHOD

Examiner: Siegfried E. Chencinski

Art Unit: 3628

SUPPLEMENTAL INFORMATION
DISCLOSURE STATEMENT UNDER 37
CFR §1.97 and §1.98

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. This application is a Continuation-in-Part of and relies upon U.S. Patent Application No. 09/516,209 ("the parent application") for an earlier effective filing date under 35 U.S.C. §120. In accordance with 37 CFR §1.98(d), copies of the references have been previously submitted to or cited by the Office in the parent application, and are therefore not enclosed.

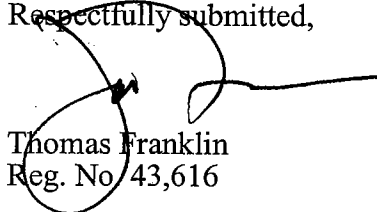
It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

This IDS is being filed before the mailing date of the final Office Action or Notice of Allowance.

Please charge the IDS fee of \$180 to Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,



Thomas Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321
TDF:nmb